UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,232	12/05/2003	Roger Thomas	P-US-PR 1111	9216

28268 7590 04/04/2006

THE BLACK & DECKER CORPORATION
701 EAST JOPPA ROAD, TW199
TOWSON, MD 21286

EXAMINER	
SELF, SHELLEY M	

ART UNIT	PAPER NUMBER
3725	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/729,232	THOMAS, ROGER	
	Examiner	Art Unit	
	Shelley Self	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5 and 14* is/are pending in the application.

4a) Of the above claim(s) *2,4 and 6-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The amendment filed on January 25, 2006 has been considered but is ineffective to overcome the prior art reference and an action on the merits follows.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 3 and 5 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of amended claims 3-7 and 9-14 of copending Application No. 10/729233. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claim 3 of copending Application No. 10/729233. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 14 are merely reworded and a broader version of the claims of the co-pending application, '233. Further the narrow claims of the co-pending application set forth a case of prima facie obviousness over the broader claims of the presently presented application. According the claims of the presently presented application fail to set forth any patentably distinguishing subject matter over that of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Eichberger et al. (5,815,934). Eichberger discloses a planer comprising a shoe (fig. 1), the shoe defining an aperture (fig. 1); a body (1) mounted on the shoe, the body including a wall and the wall defining a recess (14); a cutting drum (15) rotatably mounted within the recess, the drum having a periphery and a portion of the periphery of the cutting drum projects through the aperture in the shoe (fig. 1); a cutting blade mounted on the periphery of the drum (col. 3, lines 22) and adapted for cutting a workpiece when the drum is rotating, the cutting action of the blade causing debris created by the cutting to be ejected from the recess via a conduit (28) defined within the body for directing an airflow, the conduit connected to the recess for entraining and removing debris created by the cutting action of the blade (col. 3, lines 53-67; col. 4, lines 36-45, 60-67); a deflector (50) connectable to the conduit (fig. 4, 5) for guiding the air flow and entrained debris from within the body to outside of the body (col. 4, lines 46), the deflector having an interior and an exterior (fig. 7); and wherein the conduit directs the airflow over the exterior of the deflector, then downward to the vicinity of the recess where debris is entrained by the airflow and then to the deflector before it is guided by the deflector to outside of the body (col. 4, lines 36-67). Examiner notes that because Eicheberger's deflector (50;fig. 7) includes air passages (53) some air is inherently directed over the exterior and then redirected back (51) to facilitate disposal/ejection of the chips from the deflector (50).

With regard to claim 5, Eichberger discloses wherein the body further defines a tubular aperture (25) in communication with the conduit (fig. 4, 5), the deflector (50) includes an inner end and an outer end (fig. 7), the deflector is insertable into the planer body at a downward slope

from the outer end of the inner end in order to connect with the conduit. Examiner notes the deflector (fig. 7) having a slope, further because the deflector has a wall (55) for closing the opposite opening (fig. 5) it inherent that the deflector must be inserted at a downward slope so as to fit within the aperture (26, 27) and close the opposing opening.

With regard to claim 14, Eichberger discloses a planer comprising a shoe, the shoe defining an aperture (fig. 1); a body mounted on the shoe, the body including a wall and the wall defining a recess (14); a cutting drum (15) rotatably mounted within the recess (fig. 1), the drum having a periphery and a portion of the periphery of the cutting drum projects through the aperture in the shoe (fig. 1); a cutting blade mounted on the periphery of the cutting drum (15) and adapted for cutting a workpiece; a conduit (fig. 4, 5) defined within the body for directing airflow; an expulsion aperture (fig. 5); a deflector (50; fig. 7) connectable to the conduit wherein the conduit is connected to the recess by the expulsion aperture and the conduit directs the airflow to be blown across the expulsion aperture.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the prior art reference, Bellew et al. fails to disclose deflector (12) assembly acting as a conduit in which the opening directs airflow over the exterior of the deflector, then downward to the vicinity of the recess where debris is entrained by the airflow, and then to the deflector before it is guided by the deflector to outside of the body". Examiner notes Bellew's deflector (12) does not disclose airflow directed over the exterior of the deflector,

however, Eichberger et al. as noted above teaches this deficiency. Further because Applicant has amended the claim, removing previously positively recited structure, i.e., therefore broadening the claim(s), Eichberger is now applicable prior art and applied as noted above. Accordingly the Office Action is made final.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached

at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf
March 23, 2006

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700